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## PATENT APPLICATION

ATTORNEY DOCKET NO. 10010232.1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Mimi Chu Dong et al.

Confirmation No.: 3290

Application No.: 09/878,564

Examiner: Qamrun Nahar

Filing Date: June 11, 2001

Group Art Unit: 2191

Title: System and Method for Providing Application Software for a Peripheral Device

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 27, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( ) one month	\$120.00
( ) two months	\$450.00
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( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: 29

Typed Name: Shreen K. Danamraj

Signature: Shreen K. Danamraj

Respectfully submitted,

Mimi Chu Dong et al.

By Shreen K. Danamraj

Shreen K. Danamraj

Attorney/Agent for Applicant(s)

Reg. No. 41,696

Date: June 24, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re patent application of: §  
 Mimi Chu Dong et al. § Confirmation No.: 3290  
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For: SYSTEM AND METHOD FOR PROVIDING APPLICATION SOFTWARE FOR A  
 PERIPHERAL DEVICE

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*Shreen K. Damamraj*  
 Shreen K. Damamraj

Dear Sir:

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Pursuant to 37 C.F.R. §41.37, Applicant hereby submits an  
 appeal brief in the above-captioned patent application within the  
 requisite time from the date of filing of the Notice of Appeal  
 which was filed on April 27, 2005.

This appeal is from the decision of Examiner Qamrun Nahar, Art  
 Unit 2124, rejecting all pending claims 1-30 in the present patent  
 application, as set forth in the Final Office Action dated December  
 23, 2004 and the subsequent Advisory Action dated April 7, 2005.

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I. REAL PARTY IN INTEREST

The real party in interest of the present patent application is Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any other prior and/or pending appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or otherwise have a bearing on the Board's decision in this pending appeal.

III. STATUS OF CLAIMS

Claims 1-30 are currently pending, of which claims 1, 18, 22, and 28 are in independent form.

Claims 1-30 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,009,480 to Pleso.

Claims 28-30 stand rejected in the pending Final Office Action under 35 U.S.C. §112, second paragraph, on the basis of certain informalities. Appellant attempted to rectify these informalities so as to place the claims on appeal in better form by way of amendment filed on February 22, 2005, which was not entered by the Examiner. Appellant respectfully submits Appellant will amend the

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claims to the extent necessary to rectify these pending \$112 rejections in compliance with 37 C.F.R. §41.31(c) during this appeal or based upon a decision on the merits by the Board.

#### IV. STATUS OF AMENDMENTS

No substantive amendments have been made or requested since the mailing of the Final Office Action and amendments submitted prior to the Final Office Action have been entered. Set forth below is a brief chronology:

A Final Office Action was mailed on December 23, 2004.

Appellant filed a Response to the Final Office Action on February 22, 2005, which contained minor amendments as to the form of some of the pending claims.

An Advisory Action was mailed on April 7, 2005.

Appellant filed a Notice of Appeal on April 27, 2005 in response to the Advisory Action and Final Office Action.

A copy of the current claims is attached hereto as an Appendix.

#### V. SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the subject matter defined in each of the independent claims is set forth in this Section, including appropriate references to the specification, e.g., by page and line

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number, reference numerals in drawings, etc. These specific references are examples of particular elements of the drawings for certain embodiments of the claimed invention, and the claims are not limited solely to the elements corresponding to the applied reference numerals.

Independent claim 1 is directed to a method (see, e.g., FIGURE 3 and related description in the specification at page 6, line 26 through page 8, line 13) for providing application software for a peripheral device (102) to be installed in a computer system (104). Exemplary application software (see FIGURE 2 and related description in the specification at page 6, lines 6-25) is rendered (step 302) into a memory module (108) (see FIGURE 1 and related description in the specification at page 5, lines 16-26) coupled to the peripheral device (102) (see, e.g., the specification at page 4, lines 12-20). Upon coupling the peripheral device (102) (step 304) to the computer system (104) by a user, an operating system (106) executing on the computer system (104) (see FIGURE 1 and related description in the specification at page 4, line 21 through page 5, line 10) queries (step 306) the peripheral device (102). Responsive to the querying, the application software is uploaded (step 310) into the computer system (104) from the memory module (108) coupled to the peripheral device (102). The application software comprises software for effectuating user-customizable

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settings with respect to operating the peripheral device (102) (see, e.g., FIGURE 2 and related description in the specification at page 6, lines 6-25 with respect to elements 202, 204, 206, 208; see also FIGURE 3 and related description in the specification at page 8, lines 6-13 with respect to customization of settings by a user or customer).

Independent claim 18 is directed to a system (100) for providing application software for a peripheral device (102) to be installed in a computer system (104). The system (100) includes a memory module (108) (see FIGURE 1 and related description in the specification at page 5, lines 16-26) associated with the peripheral device (102) (see, e.g., the specification at page 4, lines 12-20), wherein the memory module (108) includes the exemplary application software (see FIGURE 2 and related description in the specification at page 6, lines 6-25). A means (see, e.g., operating system 106) associated with the computer system (104) (see FIGURE 1 and related description in the specification at page 4, line 21 through page 5, line 10) is provided for querying the peripheral device (102) when the peripheral device (102) is operably coupled to the computer system (104). A means (see, e.g., logic block 109 and related description in the specification at page 5, line 26 through page 6, line 5) is included in the peripheral device (102), the means (see, e.g.,

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logic block 109) being operable to upload the application software into the computer system (104) from the memory module (102) based on control signals provided to the peripheral device (102) from the computer system (104). The application software comprises software for effectuating user-customizable settings with respect to operating the peripheral device (102) (see, e.g., FIGURE 2 and related description in the specification at page 6, lines 6-25 with respect to elements 202, 204, 206, 208; see also FIGURE 3 and related description in the specification at page 8, lines 6-13 with respect to customization of settings by a user or customer).

Independent claim 22 is directed to a computer-readable medium (see, e.g., the specification at page 8, lines 13-21) that is operable in association with a computer system (104) (see FIGURE 1) to which a peripheral device (102) (see, e.g., the specification at page 4, lines 12-20) is to be coupled, the computer-readable medium carrying a sequence of instructions which, when executed in conjunction with the computer system (104), cause the following steps to be performed. Upon coupling (step 304 in FIGURE 3) the peripheral device (102) to the computer system (104) by a user, the peripheral device (102) is queried (step 306) by an operating system (106) executing on the computer system (104) (see FIGURE 1 and related description in the specification at page 4, line 21 through page 5, line 10). A determination is made whether a memory

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module (108) (see FIGURE 1 and related description in the specification at page 5, lines 16-26) associated with the peripheral device (102) includes application software compatible with the computer system (104), the operating system (106), or both (see, e.g., the specification at page 7, lines 21-27), the application software for operating the peripheral device (102) in association with the computer system (104). Responsive to the determination, the application software is uploaded (step 310) into the computer system (104) (see FIGURE 3 and related description in the specification at page 7, line 28 through page 8, line 5). The application software comprises software for effectuating user-customizable settings with respect to operating the peripheral device (102) (see, e.g., FIGURE 2 and related description in the specification at page 6, lines 6-25 with respect to elements 202, 204, 206, 208; see also FIGURE 3 and related description in the specification at page 8, lines 6-13 with respect to customization of settings by a user or customer).

Independent claim 28 is directed to a peripheral device (102) that is operable in association with a computer system (104) (see FIGURE 1 and related description in the specification at page 4, lines 8-20). The peripheral device (102) comprises storage means (see, e.g., memory module 108; see also FIGURE 1 and related description in the specification at page 5, lines 16-26) for



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storing application software for the peripheral device (102). A means (see, e.g., logic block 109 and related description in the specification at page 5, line 26 through page 6, line 2) is included in the peripheral device (102), the means (see, e.g., logic block 109) being operable to upload the application software into the computer system (104) from the storage means (e.g., memory module 102) based on control signals provided to the peripheral device (102) from the computer system (104). The application software comprises software for effectuating user-customizable settings with respect to operating the peripheral device (102) (see, e.g., FIGURE 2 and related description in the specification at page 6, lines 6-25 with respect to elements 202, 204, 206, 208; see also FIGURE 3 and related description in the specification at page 8, lines 6-13 with respect to customization of settings by a user or customer).

#### VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-30 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,009,480 to Pleso.

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VII. ARGUMENT

Claims 1-30 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,009,480 to Pleso (hereinafter the *Pleso* reference).

As currently constituted, each of the independent claims, claims 1, 18, 22, and 28, comprises, *inter alia*, the limitation that "said application software including software for effectuating user-customizable settings with respect to operating said peripheral device". Appellant respectfully submits that the *Pleso* reference does not teach or suggest this limitation.

The *Pleso* reference appears to be directed to an "integrated device driver wherein the peripheral downloads the device driver via an I/O device after it is determined that the I/O device has the resources to support the peripheral device." Purportedly, the *Pleso* reference overcomes the problems associated with conventional techniques for installing device drivers by incorporating the device driver within the peripheral device to be installed. Additionally, the integrated device driver system of the *Pleso* reference provides for automatic downloading of the device driver, which may be operating system and/or processor independent, thereby avoiding user intervention. See column 2, lines 39-65. In operation, when a new device (e.g., printer 52) is found, the computer processor 12 of a host system 54 queries the printer 52

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for what resources the printer 52 needs (e.g., interrupts, DMA channels, address space, et cetera). Upon determining by the processor via a look-up table that appropriate resources are available, a driver download sequence is initiated. See column 8, lines 19-35. This step involves downloading the peripheral device driver from the peripheral device to the host computer system 54. See column 8, lines 36-42. Pleso teaches that the manner of downloading may vary based on the type of interface between the host computer and the peripheral device (e.g., using a particular bit rate for the ISA bus interface, see column 8, line 56 to column 9, line 4). Appellant respectfully asserts that this processor-driven interaction between the peripheral device and the processor is not the same as uploading application software that comprises software for effectuating user-customizable settings, which enables user interaction with the peripheral device for customizing the operation of the peripheral device. In other words, Pleso appears concerned with processor-based "customization" of transferring a device driver from a peripheral device to a host computer. In contrast, Appellant's claims recite, *inter alia*, transferring application software from a peripheral device to a host computer, which application software comprises software for effectuating customization of settings by a user relative to the peripheral device's operation.

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Additionally, responsive to Appellant's Response to the December 23, 2004 Final Office Action, the Examiner commented as follows in the Advisory Action of April 7, 2005:

Examiner's Response: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., application software comprises software for effectuating customization of settings by a user relative to the peripheral device's operation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). That is, in claims 1, 18, 22 and 28, the operating system of the computer queries and uploads the application software, which comprises software for effectuating user-customizable settings with respect to operating said peripheral device. These claims do not recite that the USER is customizing the software. These claims merely require the computer system to query and upload the application software, which Pleso does. See Advisory Action at Paragraph 11.

Appellant respectfully disagrees and submits that the feature upon which Appellant relies (i.e., application software comprises software for effectuating customization of settings by a user relative to the peripheral device's operation) is provided in the rejected base claims. Appellant respectfully contends that the recited language "software for effectuating user-customizable settings" in each of the base claims is the same as "software for effectuating customization of settings by a user" in scope and meaning. In parsing the recited language, it can be seen that

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"customizable" is an adjective with the meaning "capable of being personalized and modified to order." See *Webster's New Millennium Dictionary of English, Preview Edition* (v 0.9.6) Copyright 2003-2005 Lexico Publishing Group, LLC (word entry can be found at [www.dictionary.com](http://www.dictionary.com)). Thus, the phrase "user-customizable" refers to "customization by a user", wherein the object of customization is "settings with respect to operating said peripheral device", which is the same in meaning and import as "settings ... relative to said peripheral device's operation".

For at least the foregoing reasons, Appellant respectfully submits that the Examiner's contention that "the features upon which applicant relies (i.e., application software comprises software for effectuating customization of settings by a user relative to the peripheral device's operation) are not recited in the rejected claim(s)" is without merit.

Accordingly, Applicant respectfully submits that the pending base claims 1, 18, 22, and 28, as well as the dependent claims that respectively depend therefrom, are allowable over the Pleso reference.

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CONCLUSION

In view of the foregoing discussion, Appellant respectfully submits that the rejection of the pending claims 1-30 based on Pleso under 35 U.S.C. §102(b) is not proper. Accordingly, Appellant respectfully requests that the rejection of the pending claims 1-30 be overturned by the Board, and that the present patent application be allowed to issue as a patent with all pending claims.

Respectfully submitted,

Dated: 6/24/05

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VIII. APPEALED CLAIMS - APPENDIX

1. A method for providing application software for a peripheral device to be installed in a computer system, comprising:

rendering said application software into a memory module coupled to said peripheral device;

upon coupling said peripheral device to said computer system by a user, querying said peripheral device by an operating system executing on said computer system; and

responsive to said querying, uploading said application software into said computer system from said memory module coupled to said peripheral device, said application software including software for effectuating user-customizable settings with respect to operating said peripheral device.

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2. The method of claim 1, wherein said rendering said application software into a memory module comprises programming a flash read-only memory (ROM) module with said application software.

3. The method of claim 1, wherein said application software comprises at least one of customer usage application software, customer support diagnostic application software, driver software and at least one default setting with respect to said peripheral device.

4. The method of claim 1, wherein said rendering said application software into a memory module comprises programming a nonvolatile memory (NVM) module with said application software.



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5. The method of claim 1, wherein said rendering said application software into a memory module comprises programming an electrically programmable read-only memory (EPROM) module with said application software.

6. The method of claim 1, wherein said rendering said application software into a memory module comprises programming an electrically erasable programmable read-only memory (EEPROM) module with said application software.

7. The method of claim 1, wherein said rendering said application software into a memory module comprises programming a nonvolatile random access memory (NVRAM) module with said application software.

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8. The method of claim 1, wherein said querying said peripheral device comprises making a determination by said operating system whether said application software is compatible with said operating system.

9. The method of claim 1, wherein said querying said peripheral device comprises making a determination by said operating system whether said application software is compatible with said computer system.

10. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with Microsoft® Windows® operating system.

11. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with a UNIX-based operating system.

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12. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with Linux® operating system.

13. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with Macintosh® MacOS® operating system.

14. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with Solaris® operating system.

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15. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with AIX® operating system.

16. The method of claim 1, wherein said querying said peripheral device by said operating system is performed in association with HP-UX® operating system.

17. The method of claim 1, wherein said peripheral device is selected from the group consisting of: a printer, a digital camera and a scanner.

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18. A system for providing application software for a peripheral device to be installed in a computer system, comprising:

a memory module associated with said peripheral device, said memory module including said application software;

means associated with said computer system for querying said peripheral device when said peripheral device is operably coupled to said computer system; and

means in said peripheral device operable to upload said application software into said computer system from said memory module based on control signals provided to said peripheral device from said computer system, said application software including software for effectuating user-customizable settings with respect to operating said peripheral device.

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19. The system of claim 18, wherein said memory module comprises one of a flash ROM module, an EPROM module, an EEPROM module and an NVRAM module.

20. The system of claim 18, wherein said application software comprises at least one of customer usage application software, customer support diagnostic application software, driver software and at least one default setting with respect to said peripheral device.

21. The system of claim 18, wherein said peripheral device is selected from the group consisting of: a printer, a digital camera and a scanner.

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22. A computer-readable medium operable in association with a computer system to which a peripheral device is to be coupled, said computer-readable medium carrying a sequence of instructions which, when executed in conjunction with said computer system, causes the following steps to be performed:

upon coupling said peripheral device to said computer system by a user, querying said peripheral device by an operating system executing on said computer system;

determining whether a memory module associated with said peripheral device includes application software compatible with at least one of said computer system and said operating system, said application software for operating said peripheral device in association with said computer system; and

responsive to said determining step, uploading said application software into said computer system, said application software including software for effectuating user-customizable settings with respect to operating said peripheral device.

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23. The computer-readable medium of claim 22, wherein said memory module is selected from the group consisting of: a flash ROM module, an EPROM module, an NVRAM module and an EEPROM module.

24. The computer-readable medium of claim 22, wherein said peripheral device is selected from the group consisting of: a printer, a digital camera and a scanner.

25. The computer-readable medium of claim 22, wherein said operating system is selected from the group consisting of a Unix-based operating system, Microsoft® Windows® operating system, Windows® NT® operating system and Macintosh® MacOS® operating system.



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26. The computer-readable medium of claim 22, wherein said application software comprises at least one of customer usage application software, customer support diagnostic application software and driver software.

27. The computer-readable medium of claim 22, wherein said application software comprises at least one default setting with respect to said peripheral device.

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28. A peripheral device operable in association with -a computer system, comprising:

storage means for storing application software for said peripheral device; and

means in said peripheral device operable to upload said application software into said computer from said storage means based on control signals provided to said peripheral device from said computer system, said application software including software for effectuating user-customizable settings with respect to operating said peripheral device.

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29. The peripheral device of claim 28, wherein said storage means comprises at least one of a flash ROM block, an EPROM block, an EEPROM block and an NVRAM block.

30. The peripheral device of claim 28, wherein said storage means is operable to store application software comprising at least one of customer usage application software, customer support diagnostic application software, driver software and at least one default setting with respect to said peripheral device.

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IX. EVIDENCE - APPENDIX

None.

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**X. RELATED PROCEEDINGS - APPENDIX**

None.